

REMARKS

In the Office Action¹, the Examiner objected to claims 5, 8 and 30; rejected claims 25-36 under 35 U.S.C. § 101; rejected claims 1-20 and 25-36 under 35 U.S.C. § 112, second paragraph; rejected claims 1-5, 7-13, 19-20, 25-31, and 33-36 under 35 U.S.C. § 103(a) as unpatentable over US Patent 5721906 to Siefert ("*Siefert*") in view of U.S. Patent Publication No. 2003/0130994 to Singh et al. ("*Singh*"); rejected claims 6, 14-16, 18, and 32 under 35 U.S.C. § 103(a) as unpatentable over *Siefert* in view of *Singh*, and further in view of U.S. Patent Publication No. 2005/0086204 to Coiera et al. ("*Coiera*"); and rejected claim 17 under 35 U.S.C. § 103(a) as unpatentable over *Siefert* in view of *Singh* and further in view of *Coiera* and further in view of US Patent 6636837 to Nardoizzi et al. ("*Nardoizzi*").

By this amendment, Applicants amend claims 1-5, 8, 16, 18, and 25-36. Claims 1-20 and 25-36 remain pending.

I. The Objection to Claims 5, 8, and 30

The Examiner states that "[c]laims 5 and 30 recites the limitation 'data connectors' ... [t]here is insufficient antecedent basis for this limitation in the specification or drawing." (Office Action at p. 3). Claims 5 and 30 have been amended to instead recite "descriptions of the sources of the attributes," which is supported by at least page 7, [0033] of the instant application. Therefore, Applicants respectfully request the Examiner to withdraw the objection to claims 5 and 30.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

The Examiner states that "claim 8 ... ends with two periods." (Office Action at p. 3). Claim 8 has been amended to delete the extra period. Therefore, Applicants respectfully request the Examiner to withdraw the objection to claim 8.

II. The Rejection of Claims 25-36 under 35 U.S.C. § 101

Regarding this rejection, the Examiner states:

... the claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

... When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. . .

Further more, claims 25-36 are rejected under 35 U.S.C. 101 for failing to place the invention squarely within one statutory class of invention. On page 19, paragraph [0063], lines 7-10 of the instant specification, applicant has provided evidence that applicant intends the "medium" to include signals. As such, the claim is drawn to a form of energy. Energy is not one of the four categories of invention and therefore this claim(s) is/are not statutory. Energy is not a series of steps or acts and thus is not a process. Energy is not a physical article or object and as such is not a machine or manufacture. Energy is not a combination of substances and therefore not a composition of matter.

(Office Action at pp. 3-5). Applicants respectfully traverse the rejection of claims 25-36 under 35 U.S.C. § 101.

M.P.E.P. 2106.01 states that "'functional descriptive material' consists of data structures and computer programs which impart functionality when employed as a computer component [w]hen functional descriptive material is recorded on some computer-readable medium, it ... will be statutory in most cases." Amended claim 25

recites a "machine-readable storage medium storing instructions tangibly recorded on the storage medium" (emphasis added), and to the extent that claim 25 recites descriptive material, the descriptive material is functional. Thus, claim 25 recites statutory subject matter. Claims 26-36 are statutory at least due to their dependence from claim 25. Therefore, Applicants respectfully request the Examiner to withdraw the rejection of claims 25-36 under 35 U.S.C. § 101.

III. The Rejection of Claims 1-20 and 25-36 under 35 U.S.C. § 112

Applicants respectfully traverse the rejection of claims 1-20 and 25-36 under 35 U.S.C. § 112. However, in order to expedite prosecution, Applicants have amended claims 1, 2, 4, 16, 18, 25, 26, and 28 to even more clearly meet the requirements of 35 U.S.C. § 112. Applicants request the Examiner to withdraw the rejection of claims 1-20 and 25-36 under 35 U.S.C. § 112.

IV. The Rejection of Claims 1-5, 7-13, 19, 20, 25-31, and 33-36 under 35 U.S.C. § 103(a)

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-5, 7-13, 19, 20, 25-31, and 33-36 under 35 U.S.C. § 103(a). No *prima facie* case of obviousness has been established.

To establish a *prima facie* case of obviousness, the prior art references (or references when combined) must teach or suggest all of the claim limitations. See M.P.E.P. § 2142, 8th Ed., Rev. 5 (August 2006). Moreover, "in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have

combined the prior art elements in the manner claimed.” USPTO Memorandum from Margaret A. Focarino, Deputy Commissioner for Patent Operations, May 3, 2007, p. 2.

A *prima facie* case of obviousness has not been established because, among other things, neither *Siefert* nor *Singh*, taken alone or in combination, teach or suggest each and every element recited by Applicants’ claims.

Claim 1 recites a method including, for example, “searching the hit-list for resources having the second attributes.” The prior art fails to teach or suggest this element of claim 1.

The Examiner correctly states that “Siefert is silent with respect to receiving additional characteristics of the resource through a refinement user interface, searching the hit-list for the desired attributes; and providing a narrowed hit-list of resources matching the desired attributes.” (Office Action at p. 8). However, the Examiner alleges that [0079] and [0204], lines 5-8 of *Singh* disclose “further narrowing the result pages by providing the user with specific criteria and instructing to narrow the search parameters.” (Office Action at p. 8). Even assuming this allegation is true, which Applicants do not concede, the cited passages do not teach “providing a hit-list of resources having the one or more first attributes” and “searching the hit-list for resources having the second attributes,” as claimed in claim 1. For at least the reason that the prior art fails to teach each and every element of claim 1, no *prima facie* case of obviousness has been established. Therefore, Applicants respectfully request the Examiner to withdraw the rejection of claim 1 under 35 U.S.C. §103(a).

Claims 2-5, 7-13, 19, and 20 depend from claim 1 and are thus also allowable over *Siefert* and *Singh*, for at least the same reasons as claim 1.

Independent claim 25, although of different scope from claim 1, recites limitations similar to claim 1. Therefore, claim 25 is allowable over *Siefert* and *Singh* for at least the same reasons discussed above in regard to claim 1. Claims 26-31 and 33-36 are also allowable at least due to their dependence from claim 25.

V. The Rejection of Claims 6, 14-16, 18, and 32 under 35 U.S.C. § 103(a)

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 6, 14-16, 18, and 32. A *prima facie* case of obviousness has not been established because, among other things, the prior art, taken alone or in combination, fails to teach or suggest each and every element recited by Applicants' claims.

Claims 6, 14-16, and 18 depend from claim 1 and claim 32 depends from claim 25. As already discussed, the prior art fails to teach or suggest each and every element of independent claims 1 and 25.

The Examiner alleges that *Coiera* discloses various elements recited in claims 6, 14, 15, 16, 18, and 32. Even assuming these allegations are correct, which Applicants do not concede, *Coiera* fails to cure the deficiencies of *Siefert* and *Singh* discussed above. That is, *Coiera* also fails to teach or suggest "providing a hit-list of resources having the one or more first attributes" and "searching the hit-list for resources having the second attributes," as recited in claims 1 and 25.

For at least the reason the prior art fails to teach or suggest each and every element of claims 1 and 25, no *prima facie* case has been established with respect to claims 1 and 25. Claims 6, 14-16, 18, and 32 depend from claim 1 or 25 and are therefore allowable. Therefore, Applicants respectfully request the Examiner to withdraw the rejection under 35 U.S.C. § 103(a) and allow claims 6, 14-16, 18, and 32.

VI. The Rejection of Claim 17 under 35 U.S.C. § 103(a)

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 17. A *prima facie* case of obviousness has not been established because, among other things, the prior art, taken alone or in combination, fails to teach or suggest each and every element recited by Applicants' claims.

Claim 17 depends from claim 1. As already discussed, the prior art fails to teach or suggest each and every element of independent claim 1.

The Examiner relies on *Nardozzi* for allegedly disclosing that "the search template is auto-configured based on the resource type, attributes, or facets," as recited in claim 17. Even assuming this assertion is true, which Applicants do not concede, *Nardozzi* fails to cure the deficiencies of *Siefert*, *Singh*, and *Coiera* discussed above. That is, *Nardozzi* does not teach or suggest "providing a hit-list of resources having the one or more first attributes" and "searching the hit-list for resources having the second attributes," as recited in claim 1 and required by claim 17.

For at least the reason that the prior art fails to teach or suggest each and every element recited in claim 1 and required by claim 17, no *prima facie* case has been

established with respect to claim 17. Therefore, Applicants respectfully request the Examiner to withdraw the rejection under 35 U.S.C. § 103(a) and allow claim 17.

VII. Conclusion

In view of the foregoing remarks, Applicants submit that this claimed invention is neither anticipated nor rendered obvious in view of the cited art. Applicants therefore request the Examiner's reconsideration and reexamination of the application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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